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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,922	06/13/2001	Karin Angela Hing	HING3001/REF	8656
7590		07/27/2006	EXAMINER	
Bacon & Thomas		HOFFMANN, JOHN M		
625 Slaters Lane		ART UNIT		
4th Floor		PAPER NUMBER		
Alexandria, VA 22314		1731		

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,922

Applicant(s)

HING ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-27 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16,20-27,33 and 35-40 is/are rejected.
- 7) ☒ Claim(s) 17-19,32 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3-20-2006 has been entered.

Claims 17-19, 32 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 17 requires evaporating the carrier prior to the burn-out. But claim 1 requires burn-out of the slip. When the carrier is evaporated, the slip no longer exists: see page 3 (lines 16-18) of the present specification which indicates that the term "slip" is commensurate with its conventional usage. That is, a slip is a slurry. It is clear that claim 17 requires that the liquid/water has been evaporated – thus the slip no longer exists. Claim 17 requires the burn out occur on the casting (which is not a slip); this is mutually exclusive of claim 1 which requires the burn out of the slip. Thus, claim 17 does not further limit claim 1, rather it takes the claim to a scope which is mutually exclusive from that of claim 1.

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To look at it another way: Claim 17 is directed to Applicant's disclosed to those specific embodiments where it is a casting that is heated to burn out. A slip is a fluid; a casting is a body. But claim 1 is directed to the invention where the burnout comes without converting the slip into a body. These are two mutually exclusive inventions.

Claim 32 merely states a preference and has no requirements or limitations. Thus claim 32 does not further limit a previous claim.

Claim 34 depends on claim 3 which has been cancelled.

Claims 17-19 and 32 and 34 are not further treated on its merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-16, 20-27, 33 and 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 step (a) first indicates that a surfactant is optional, and then indicates there is a surfactant is present if the binder is not a surfactant. These two things tend to contradict each other and thus make the claims indefinite. It is unclear if the surfactant is always optional – or if it is only optional if the binder does not function as a surfactant. The same applies to claim 40.

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Claim 1 requires 4 steps – but it is unclear if the claim is directed to all 4 steps or any one of the 4. In other words: it is unclear if one should assume that there is an “or” or an “and” between steps c and d.

Claim 1, step c requires heating “at” a temperature. Generally, heating connotes changing “from” one temperature “to” another temperature. It is unclear whether heating “at” a temperature means that the slip is maintained at a particular temperature or what. Examiner could find no guidance in the specification as to what is meant – the embodiments are all directed to heating the casting, not the slip.

From MPEP 2173.05(h):

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925).

Presently, claim 7 has a group which is very similar to the above accepted form, but there is no indication that the group is “consisting of” the members. Therefore it is impossible for anyone to tell if applicant’s group is open or closed to additional members - and thus the claim presents uncertainty or ambiguity with respect to the question of scope of the claim. If the above “acceptable form” is not desirable for Applicant, Examiner can be telephoned for other expressions. The same applies to claim 10 and 16.

Claim 7: the term “AW-glass” is indefinite as to its meaning. Examiner could not find any definition or explanation for this term in the present application or via and EAST text search. This is deemed to be a *prima facie* showing that one would not be

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able to ascertain what is meant by the term. The burden is now on applicant to demonstrate that one would be able to understand what is meant by the term.

Claim 12: the term "w/v %" is indefinite as to its meaning. It is unclear if the "/" means "or" as it does in claim 4. If the term is to mean weight: volume % - it is not stated what the units of the weight or the units of the volume are. Is it pounds/pints, gram/liter, tons/cubic yard or what. The same applies to claims 13-15.

Allowable Subject Matter

It appears that the claims are novel/unobvious because of the heating of the slip as claimed. However since the language of "at" is in question (see above) the Office does not wish to indicate allowable subject matter. It is noted that MPEP 2111.01 indicates:

(Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400oF to 850oF" required heating the dough, rather than the air inside an oven, to the specified temperature.)

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

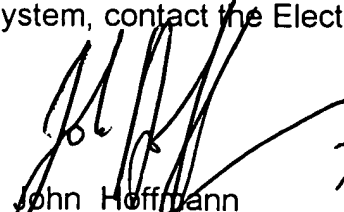
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fischer is cited to show that the use of ball mills is conventional and for indicating various advantages for its usage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

7-24-06

jmh